

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/899,817

REMARKS

This amendment, submitted in response to the Office Action dated September 25, 2002, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

The Office Action raises an informality. Per the suggestion of the Examiner, claim 1 has been modified with respect to the image processor, as indicated in the Appendix. This should not narrow the scope of the claim, but merely clarifies what is being claimed with respect to the image processor.

Turning to the merits of the Office Action, claims 1-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki (USP 6,072,916) in view of Kashiwagi (USP 5,126,540). Applicant submits the following arguments in traversal of the Section 103(a) rejection.

Claim 1, 6, and 9

With respect to claim 1, 6 and 9, the Examiner cites Suzuki for disclosing an image forming apparatus comprising a reading device for photoelectrically reading an image of an original to obtain digital image data, an image processor for subjecting the digital image data to predetermined image processing to obtain processed image data, a printer for outputting a print according to the processed image data, and an image recording device for outputting the image processed data to an image file.

The Examiner concedes that Suzuki does not disclose outputting the print with the printer and outputting the image file with the image recording device further comprising an original

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identifying information input device for inputting information for identifying the original before the original is read and a database for storing the inputted original identifying information in relation to the image file, as described in claims 1, 6 and 9.

The Examiner maintains that Kashiwagi discloses the elements missing in Suzuki. Kashiwagi pertains to a bar code reading apparatus that reads the bar codes off of a piece of paper so that the *original document* can be photographed and recorded onto microfilm and indexed with the corresponding bar code. Column 3, lines 9-19. So as not to affect the recording process, any document which does not contain a bar code, or if the bar code cannot be read, is sent to a reject tray. Column 6, lines 26-32. If the bar code is read, it is then stored in memory.

Firstly, there is no motivation to combine Kashiwagi with Suzuki. Suzuki provides for *high speed and continuous* reading of images by a scanner to increase throughput. Column 1, lines 9-14. Kashiwagi requires that the bar code of a document be initially read before a document can be scanned. Column 6, lines 26-32. If there is no bar code, then an operator must intervene and enter the index data by the pen scanner or key input unit and the original is *fed again*. Column 6, lines 45-55. Therefore, Kashiwagi teaches continuous *interruption* of the reading process. If Suzuki were required to determine the existence of a bar code, prior to reading, the *continuous* reading of images as desired, would be undermined. Modifications that contradict a principle of operation of a reference do not support prior art rejections. MPEP 2143.01. Thus, Suzuki cannot be modified based on Kashiwagi.

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Secondly, the Examiner states that Kashiwagi discloses a database in col. 4, ll. 3-6. Office Action p. 3. All the information entered by said input means are supplied to a control circuit in the photographing unit, then to the computer and stored in the memory thereof. The memory is not storing information for identifying the image forming apparatus or the laboratory where the image forming apparatus is installed together with the image file and the information for identifying the original as required by claim 6, but is merely storing the bar code number.

Column 6, lines 16-17.

Thirdly, at no point does Kashiwagi disclose reading out, when a *reprint* is requested by designating the original identifying information as required by claim 9. Therefore, independent claims 1 and 9 are patentable for at least these reasons. The remaining claims 2-8 are patentable based on their dependency.

Claim 3

Regarding claim 3, the Examiner states that Suzuki in view of Kashiwagi discloses the image forming apparatus where the original identifying information input device is the reading device for photoelectrically reading the original and an identifier having a marker attached thereto, which shows information for identifying the original and can be photoelectrically read, is disposed to an extreme end of original and the marker is read by the reading device at the *same time* as the image of the original is read.

The apparatus in Kashiwagi does not read the identification information and the image at the *same time* as described by the claimed invention. In Kashiwagi, the bar code is read first. *Upon determining* that a bar code exists, the document will then be scanned. If there is no bar

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code, then the document is rejected. Column 6, lines 7-45. The bar code and the document to be imaged are not read at the *same time* as required by the claim 3. Kashiwagi does not disclose this element because Kashiwagi merely sorts out documents which have a bar code from those that do not so that documents can be scanned according to their bar code. There would be no point in reading a document without a bar code, since a document imaged without a bar code would be improperly indexed.

Claim 4

As stated above, the apparatus in Kashiwagi does not read the identification information and the image at the *same time* as described by claim 4. In Kashiwagi, the bar code is read first.

Claim 5

Regarding claim 5, it is unclear whether original identifying information input device is a device through which operator inputs information for identifying the original as a *character string* is disclosed in Suzuki or Kashiwagi. Any ambiguities must be construed against the Examiner. The Examiner states that such elements are disclosed in col. 8, ll. 53-57, but the respective column and rows in Suzuki disclose that a photosensitive material is subject to processing in baths, dried, and cut to a predetermined length corresponding to a print and output, and the respective column and rows in Kashiwagi disclose a warning lamp which is turned on to warn the operator in case the photographing operation is conducted without the index data. Therefore, the Examiner has failed to demonstrate where the prior art discloses the requirements of claim 5.

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Claim 7

At no point do Suzuki or Kashiwagi disclose *back printing* the information for identifying the original on the print as required by claim 7. Back printing is a feature on a printer that can automatically add date, time, or specific text to the backside of the picture. At no point does Kashiwagi teach or suggest that the disclosed device could create prints with information on the back.

In addition, the device in Kashiwagi is not putting anything on paper, but is doing the exact opposite. Kashiwagi is trying to do away with paper, and is putting the paper on a recording medium. See Background of the Invention. The claimed invention is doing the opposite since it is giving a customer the ability to put a photoelectric recording onto paper. Since the goal of Kashiwagi is contrary to that of the claimed invention, Kashiwagi combined with any reference, would not meet the claimed invention. Therefore, claim 7 is patentable.

Applicant has added claims 10-19 to describe the invention more particularly.

The invention permits a customer to request *copies* of images, *without* requiring the *original* film, as described in newly added claims 10-12. The user merely possesses identification information which identifies the image forming apparatus or the laboratory where the image forming apparatus is installed. An operator will enter the identification information into a database and in return the database will read out the aforesaid information. The images can then be retrieved and reproduced per the customer's request without the original film. Kashiwagi allows determination of whether or not to read the identifying information, according to whether said identifying information is present *on the original*. Column 7, lines 31-34. Since

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Kashiwagi requires the *original* in order to read the bar code information, its teaching is contrary to the additional claims. Column 6, lines 43-45.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

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APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The specification is changed as follows:

Page 12, line 24 to page 13, lines 1-4.

The reading conditions for each frame in the fine scan are set such that the image sensor 34 is [sathurated] saturated at a density which is somewhat lower than the minimum density of each image (frame) using the image data (prescanned data) obtained by the prescan.

Page 18, lines 5-11.

Next, the operator [the] places the film F [to] onto the carrier 30 and reads the film F with the scanner 12 in the sequence of frames. At this time, first, light is irradiated to the check tape 62 pasted to the extreme end of the film F and the reflected light therefrom is received by the image sensor 34 so that the original identifying information is read. With this operation, the original can be confirmed.

Page 21, lines 7-15.

As described above in detail, according to this embodiment, since information for identifying an original is inputted and stored in relation to an image file before image data is obtained by reading an image with a scanner, a corresponding image file can be simply designated when a reprint is requested, which permits the reprint to be simply produced from the image file without a film. Accordingly, a procedure for requesting a reprint can be very [simplified] simple.



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IN THE CLAIMS:

The claims are amended as follows:

1. (Amended) An image forming apparatus comprising:

 a reading device for photoelectrically reading an image of an original to obtain digital image data;

 an image processor for subjecting the digital image data to a predetermined image processing to obtain a processed image data;

 a printer for outputting a print according to the processed image data; and

 an image recording device for outputting the image processed data to an image file;

wherein

 both of outputting said print with the printer and outputting said image file with the image recording device;

 further comprising:

 an original identifying information input device for inputting information for identifying the original before the original is read; and

 a data base for storing the inputted original identifying information in relation to the image file.

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